

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Eugeny A. Lukhtanov et al.

Application No.: 10/507,267

Filed: April 6, 2005

For: NEGATIVELY CHARGED  
MINOR GROOVE BINDERS

Customer No.: 20350

Confirmation No. 4902

Examiner: Staples, Mark

Technology Center/Art Unit: 1637

REQUEST TO CORRECT  
INVENTORSHIP UNDER 37 C.F.R.  
§1.48(b)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Applicants respectfully request Correction of Inventorship under 37 C.F.R. §1.48(b) by **removing** currently named inventor **Sergey G. Lokhov**, who was originally properly included as an inventor. Due to claim amendments made during prosecution, however, the contribution of **Sergey G. Lokhov** is no longer being claimed in this application.

The Commissioner is authorized to charge Deposit Account No. 201430 for the processing fee of \$130 set forth in 37 C.F.R. § 1.17(i) for filing this Request

Respectfully submitted,



Zhe Wu  
Reg. No. 52,377

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 925-472-5000  
Fax: 415-576-0300  
Z1W:daw  
61792408 v1

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Eugeny A. Lukhtanov et al.

Application No.: 10/507,267

Filed: April 6, 2005

For: NEGATIVELY CHARGED  
MINOR GROOVE BINDERS

Customer No.: 20350

Confirmation No. 4902

Examiner: Staples, Mark

Technology Center/Art Unit: 1637

REQUEST TO CORRECT  
INVENTORSHIP UNDER 37 C.F.R.  
§1.48(a)

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

Pursuant to the provisions of 37 C.F.R. § 1.48(a), Applicants respectfully request that Alexander A. Gall be added as an inventor of the above-identified patent application.

As required under 37 C.F.R. § 1.48(a), the following documents are submitted herewith:

1. Statements from additional inventor Alexander A. Gall stating that there was no deceptive intent in the exclusion from inventorship on the original application;
2. Substitute Declaration by the actual inventors;
3. Processing fee under 37 C.F.R. 1.17(i); and
4. Consent of Assignee.

The Commissioner is authorized to charge Deposit Account No. 20-1430 for the processing fee of \$130 set forth in 37 C.F.R. § 1.17(i) for filing this Request. Please charge any additional fees or credit overpayment to the above Deposit Account.

Respectfully submitted,



Zhe Wu  
Reg. No. 52,377

TOWNSEND and TOWNSEND and CREW LLP  
Two Embarcadero Center, Eighth Floor  
San Francisco, California 94111-3834  
Tel: 925-472-5000  
Fax: 415-576-0300  
Z1W:daw  
61792461 v1

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

In re application of:

Eugeny A. Lukhtanov et al.

Application No.: 10/507,267

Filed: April 6, 2005

For: **NEGATIVELY CHARGED  
MINOR GROOVE BINDERS**

Examiner: Mark Staples

Art Unit: 1637

DECLARATION UNDER

37 C.F.R. §1.132

Commissioner for Patents  
P.O. BOX 1450  
Washington, D.C. 20231

Sir:

We, the undersigned inventors, declare as follows:

1. We are among the co-inventors of the invention claimed in the above-captioned patent application (U.S. Patent Application No. 10/507,267, "the '267 application").
2. We are among the co-inventors of U.S. Patent No. 6,790,945, filed June 6, 2001, and entitled "Fluorescent Quenching Detection Reagents and Methods" ("the '945 patent").
3. With respect to the subject matter that is both disclosed in the '945 patent and also disclosed and claimed in the '267 application, we are the only inventors of the subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application.
4. We alone conceived of the subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application.
5. We further declare and state that Robert Dempcy is not co-inventor of the subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application. The subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application was derived from our inventive work.

Robert Dempcy did not have a role in the conception and discovery of the subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application.

6. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 02/10/09

E Lukhtanov  
Eugeny A. Lukhtanov

02-09-09

Nicolas M.J. Vermeulen  
Nicolas M.J. Vermeulen

Feb 9, 2009

Alexander A. Gall  
Alexander A. Gall

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Eugeny A. Lukhtanov et al.

Application No.: 10/507,267

Filed: April 6, 2005

For: NEGATIVELY CHARGED  
MINOR GROOVE BINDERS

Examiner: Mark Staples

Art Unit: 1637

STATEMENTS BY EUGENY A.  
LUKHTANOV AND NICOLAAS M.J.  
VERMEULEN REGARDING THE  
DECLARATION EXECUTED ON  
JANUARY 9, 2008

Commissioner for Patents  
P.O. BOX 1450  
Washington, D.C. 20231

Sir:

We, the undersigned inventors, state as follows:

1. We are among the co-inventors of the invention claimed in the above-captioned patent application (U.S. Patent Application No. 10/507,267, "the '267 application").
2. We are among the co-inventors of U.S. Patent No. 6,790,945, filed June 6, 2001, and entitled "Fluorescent Quenching Detection Reagents and Methods" ("the '945 patent").
3. We executed a Declaration under 37 CFR 1.132 on January 9, 2008, in response to the Office Action mailed August 16, 2007.
4. In the Declaration, we state that (i) Alexander A. Gall is not a co-inventor of the subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application; (ii) The subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application was derived from our inventive work; and (iii) Alexander A. Gall did not have a role in the conception and discovery of the subject matter both disclosed in the '945 patent and also disclosed and claimed in the '267 application. These statements were made based on our recollection at the time of execution of the Declaration.

5. Recently notebook evidence has established that Alexander A. Gall has made a contribution to the conception of the presently claimed invention. We were unaware of this piece of evidence at the time when we executed the Declaration on January 9, 2008. Our statements regarding the inventorship of Alexander A. Gall in the Declaration of January 9, 2008 were made without any deceptive intent on our part.

6. We state that Alexander Gall is among the co-inventors of the invention claimed in the above-captioned patent application (U.S. Patent Application No. 10/507,267, "the '267 application").

7. We hereby declare that all statements made herein of our own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Dated: 02/04/2008

E Lukhtanov

Eugeny A. Lukhtanov

02-04-08

Nicolaas M.J. Vermeulen

Nicolaas M.J. Vermeulen

**SUBSTITUTE DECLARATION (37 CFR 1.63) FOR UTILITY OR DESIGN APPLICATION  
USING AN APPLICATION DATA SHEET (37 CFR 1.76)**

Title of  
Invention

NEGATIVELY CHARGED MINOR GROOVE BINDERS

As the below named inventor(s), I/we declare that:

This declaration is directed to:

- ☐ The attached application, or  
☒ Application No. 10/507,267 filed on 04/06/05  
☐ as amended on \_\_\_\_\_ (if applicable);

I/we believe that I/we am/are the original and first inventor(s) of the subject matter which is claimed and for which a patent is sought;

I/we have reviewed and understand the contents of the above-identified application, including the claims, as amended by any amendment specifically referred to above;

I/we acknowledge the duty to disclose to the United States Patent and Trademark Office all information known to me/us to be material to patentability as defined in 37 CFR 1.56, including for continuation-in-part applications, material information which became available between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

All statements made herein of my/our own knowledge are true, all statements made herein on information and belief are believed to be true, and further that these statements were made with the knowledge that willful false statements and the like are punishable by fine or imprisonment, or both, under 18 U.S.C. 1001, and may jeopardize the validity of the application or any patent issuing thereon.

**FULL NAME OF INVENTOR(S)**

Inventor one: Eugeny A. Lukhtanov

Date: 02/09/09

Signature: E. Lukhtanov

Citizen of: Russian Federation

Inventor two: Nicolaas M.J. Vermeulen

Date: 02-08-09

Signature: N. M. J. Vermeulen

Citizen of: United States

Inventor three: Alexander A. Gall

Date: Feb. 9, 2009

Signature: Alexander Gall

Citizen of: United States

Inventor four: ---

Date: \_\_\_\_\_

Signature: \_\_\_\_\_

Citizen of: \_\_\_\_\_

☐ Additional inventors or a legal representative are being named on \_\_\_\_\_ additional form(s) attached hereto.



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Eugeny A. Lukhtanov et al.

Application No.: 10/507,267

Filed: April 6, 2005

For: NEGATIVELY CHARGED  
MINOR GROOVE BINDERS

Examiner: Mark Staples

Art Unit: 1637

STATEMENT BY OMITTED INVENTOR  
PURSUANT TO 37 CFR §1.48(a)(2)

Commissioner for Patents  
P.O. BOX 1450  
Washington, D.C. 20231

Sir:

I, Alexander A. Gall, of Woodinville, United States, states that my exclusion as an inventor for the originally filed application referenced above was made without any deceptive intent on my part.

Dated: 9 Mar 2009

Alexander Gall

Alexander A. Gall

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Eugeny A. Lukhtanov et al.

Application No.: 10/507,267

Filed: April 6, 2005

For: NEGATIVELY CHARGED  
MINOR GROOVE BINDERS

Examiner: Mark Staples

Art Unit: 1637

WRITTEN CONSENT OF ASSIGNEE TO  
CHANGE OF INVENTORSHIP UNDER  
37 C.F.R. §1.48(a)(5)

Commissioner for Patents  
P.O. BOX 1450  
Washington, D.C. 20231

Sir:

I, WILLIAM L. RESS on behalf of Epoch Biosciences, Inc., the assignee of interest in the above-referenced U.S. Patent Application, as established in a Statement under 37 C.F.R. § 3.73(b), filed at the U.S. Patent and Trademark Office on March 14, 2005, consent to the correction of inventorship of U.S. Patent Application No. 10/507,267 so as to name **Alexander A. Gall** the co-inventor.

I, hereby state that I have the authority to act on behalf of the Assignee, Epoch Biosciences, Inc.

EPOCH BIOSCIENCES, INC.

Date: February 10, 2008

By: William L. Recess

Name: William L. Recess

Title: Secretary